

REMARKS

Applicants submit this Response to the Office Action mailed November 29, 2005.

Applicants do not make any amendments to the claims relative to the Amendment After Final filed October 12, 2005. Claims 1-39 are pending in this application. Claims 1, 10, 19, 28, and 34 are independent claims.

On page 2 of the Office Action, claims 1-39 were rejection as being based upon a defective reissue declaration under 35 U.S.C. § 251. Applicants submit herewith a Supplemental Reissue Declaration Under 37 C.F.R. § 1.175. Accordingly, Applicants respectfully request withdrawal of this rejection.

On pages 2-3 of the Office Action, claims 28-39 are rejected under 35 U.S.C. § 112, second paragraph, for allegedly indefiniteness. Applicants respectfully traverse.

Page 3 of the Office Action asserts that the "claim recites the use of a random-number generating unit...the determination result'. However the claim does not recite of what is being done with the random number after being generated." As set forth in M.P.E.P. § 2173, however, what is done with the random number after it is generated is irrelevant, as the "primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." Accordingly, as the public is clearly informed of the scope of a claim including "a random-number generating circuit means for generating a random-number based on the determination result," there is no indefiniteness.

Similarly, page 3 of the Office Action asserts that "claim 34 only recite the use of a first security block for authentication, however the second security block is recorded

on the medium, is it for authentication?" Claim 34 recites "recording said reproduced information in a storage medium; said recording comprising encrypting and authenticating said reproduced information using a first security block, wherein said storage medium comprises a second security block." Accordingly, the public is clearly informed that the claimed method includes "encrypting and authenticating said reproduced information using a first security block" and "recording said reproduced information in a storage medium... wherein said storage medium comprises a second security block." As all M.P.E.P. § 2173 requires is that the public is clearly informed as to the boundaries of the claimed invention, there is no indefiniteness.

For at least the aforementioned reasons, Applicants respectfully request withdrawal of the Section 112, second paragraph rejections for alleged indefiniteness.

On pages 3-5 of the Office Action, claims 28-39 were rejected under 35 U.S.C. § 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicants respectfully traverse this rejection.

In the Amendment After Final filed October 12, 2005, Applicants amended independent claims 28 and 34 to each recite security blocks, encryption, authentication, and random-number generation. In response, page 4 of the Office Action asserts, "Applicant did not amend the claims to include all of the limitations that was previously present in the original claims. Such limitation as cited above was part of the indicated allowable subject matter within the claims."

Applicants agree that independent claims 28 and 34, as-amended by the Amendment After Final filed October 12, 2005 do not recite every aspect set forth on

page 4 of the Office Action. Applicants disagree, however, that the aspects set forth on page 4 of the Office Action were part of the indicated allowable subject matter within the claims. Indeed, the Notice of Allowability in prior Application No. 09/690,543 ("Application") does not include any Statement of Reasons for Allowance.

Independent claims 28 and 34 do not recapture any subject matter surrendered during the original prosecution of the application. Applicants' in view of a statement on page 11 of the Amendment filed April 11, 2003 in the Application that "Ashe is not concerned with security blocks for encrypting and authenticating data, and does not teach a random-number generating circuit," defines the proper limits of any alleged surrender. Because independent claim 28 and 34 recite security blocks, encrypting and authenticating data, and a random-number generating circuit, Applicants assert that as-amended independent claims 28 and 34 meet the requirements set forth in M.P.E.P. § 1412.02(2)(d) ("Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution"), and are not a recapture based on the holding of Ex Parte Eggert, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 2003).

While the aspect set forth on page 4 of the Office Action was added to the claims in the Application, any actual surrender was related to the phrase "Ashe is not concerned with security blocks for encrypting and authenticating data, and does not teach a random-number generating circuit." Accordingly, while the recitations in independent claims 28 and 34 may be broader than the aspect set forth on page 4 of

the Office Action, those recitations are still at least coextensive with the subject matter of the alleged surrender in the Application, and do not constitute recapture.

For at least the aforementioned reasons, Applicants respectfully request withdrawal of the Section 251 rejection.

Applicants further submit that rejected claims 29-33 and 35-39 depend either directly or indirectly from one of independent claims 28 and 34, and are therefore allowable for at least the same reasons that their respective independent claim is allowable.

Applicants respectfully request reconsideration and allowance of this application.

The Office Action contains characterizations of the claims with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

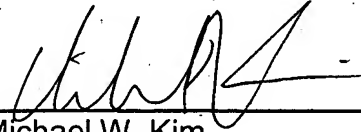
In discussing the claims in this Response, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 8, 2006

By: 
Michael W. Kim
Reg. No. 51,880

Attachment: Supplemental Reissue Declaration Under 37 C.F.R. § 1.175 (3 pages)